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OFFICE OF PETITIONS

In re Application of	:
Kouji Arai et al.	:
Application No. 10/635,764	:
Filed: August 5, 2003	:
Attorney Docket Number: 16869P-006210US	:
Title: SYSTEM AND METHOD FOR	:
REPLICATING DATA	:

This is a decision on the petition under 37 CFR §1.181(a), filed January 9, 2006, to withdraw the holding of abandonment.

BACKGROUND

The above-identified application became abandoned for failure to submit the issue and publication fees in a timely manner in reply to the Notice of Allowance and Issue Fee Due, mailed August 2, 2005, which set a shortened statutory period for reply of three (3) months. No extensions of time are permitted for transmitting issue fees or publication fees¹. Accordingly, the above-identified application became abandoned on November 3, 2005. A Notice of Abandonment was mailed on December 19, 2005.

With the present petition, petitioner has asserted that the Notice of Allowance and Issue Fee Due was never received. Petitioner has included a copy of his docket report, and has set forth that a review of both the docket records and the file jacket has not resulted in the location of this notice.

¹ See MPEP §710.02(e).

RELEVANT PORTION OF THE MPEP

MPEP 711.03(c) states, in part:

PETITION TO WITHDRAW HOLDING OF ABANDONMENT BASED ON FAILURE TO RECEIVE OFFICE ACTION

In *Delgar v. Schulyer*, 172 USPQ 513 (D.D.C. 1971), the court decided that the Office should mail a new Notice of Allowance in view of the evidence presented in support of the contention that the applicant's representative did not receive the original Notice of Allowance. Under the reasoning of *Delgar*, an allegation that an Office action was never received may be considered in a petition to withdraw the holding of abandonment. If adequately supported, the Office may grant the petition to withdraw the holding of abandonment and remail the Office action. That is, the reasoning of *Delgar* is applicable regardless of whether an application is held abandoned for failure to timely pay the issue fee (35 U.S.C. 151) or for failure to prosecute (35 U.S.C. 133).

To minimize costs and burdens to practitioners and the Office, the Office has modified the showing required to establish nonreceipt of an Office action. The showing required to establish nonreceipt of an Office communication must include a statement from the practitioner stating that the Office communication was not received by the practitioner and attesting to the fact that a search of the file jacket and docket records indicates that the Office communication was not received. A copy of the docket record where the nonreceived Office communication would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement. For example, if a three month period for reply was set in the nonreceived Office action, a copy of the docket report showing all replies docketed for a date three months from the mail date of the nonreceived Office action must be submitted as documentary proof of nonreceipt of the Office action. See Notice entitled "Withdrawing the Holding of Abandonment When Office Actions Are Not Received," 1156 O.G. 53 (November 16, 1993).

The showing outlined above may not be sufficient if there are circumstances that point to a conclusion that the Office action may have been lost after receipt rather than a conclusion that the Office action was lost in the mail (e.g., if the practitioner has a history of not receiving Office actions).

Evidence of nonreceipt of an Office communication or action (e.g., Notice of Abandonment or an advisory action) other than that action to which reply was required to avoid abandonment would not warrant withdrawal of the holding of abandonment. Abandonment takes place by operation of law for failure to reply to an Office action or timely pay the issue fee, not by operation of the mailing of a Notice of Abandonment. See *Lorenz v. Finkl*, 333 F.2d 885, 889-90, 142 USPQ 26, 29-30 (CCPA 1964); *Krahn v. Commissioner*, 15 USPQ2d 1823, 1824 (E.D. Va 1990); *In re Application of Fischer*, 6 USPQ2d 1573, 1574 (Comm'r Pat. 1988).

Two additional procedures are available for reviving an application that has become abandoned due to a failure to reply to an Office Action: (1) a petition under 37 CFR 1.137(a) based upon unavoidable delay; and (2) a petition under 37 CFR 1.137(b) based on unintentional delay.

ANALYSIS

The showing in the instant petition is not sufficient to withdraw the holding of abandonment. Although Petitioner has stated that the Office communication was not received and that he searched the file jacket and the docket records, it does not appear that Petitioner has included a copy of the file jacket.

Moreover, the copy of the docket report which Petitioner has submitted cannot be accepted, as it is illegible.

Petitioner has marked the relevant sections with yellow highlighter. This file exists as an electronic file, and as such, all incoming papers are scanned and converted to electronic documents. The electronic file has been reviewed, and a plurality of entries on the docket report are illegible - although the electronic file does not reproduce colors, it is likely that the illegible portions are those entries which Petitioner has highlighted, and the highlighting of these areas does not reproduce well when the papers are converted to black and white electronic documents.

As such, the contents of the relevant sections of this document cannot be discerned. Therefore, Petitioner has not established non-receipt of the communication, and the petition must be **DISMISSED**.

CONCLUSION

Any reply must be submitted within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time under 37 C.F.R. §1.136(a) are permitted. The reply should include a cover letter entitled "Renewed Petition Under 37 C.F.R. §1.181." This is not a final agency action within the meaning of 5 U.S.C 704.

Petitioner may wish to include a copy of the file jacket, as well as a copy of the docket report which has not been annotated in yellow highlighter.

The renewed petition should indicate in a prominent manner that the attorney handling this matter is Paul Shanoski, and may be submitted by mail², hand-delivery³, or facsimile⁴.

² Mail Stop Petition, Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.

³ Customer Window, Randolph Building, 401 Dulany Street, Alexandria, VA, 22314.

⁴ (571) 273-8300- please note this is a central facsimile number.

Telephone inquiries regarding *this decision* should be directed to the undersigned at (571) 272-3225. All other inquiries concerning examination procedures or status of the application should be directed to the Technology Center.



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